

Remarks/Arguments

Errors in Rejection

The assignee respectfully asserts that:

1. It was erroneous to use a published U.S. patent application by Bloom, US 2002/0178074 A1, to reject Claims 1-17, because Bloom is not available for use by the Examiner as a reference. The Assignee submits a Declaration under 37 CFR 1.131, to prove a date of invention that antedates Bloom.
2. Even if Bloom had been available for use by the Examiner as a reference, it was erroneous to reject Claims 1-3 and 5-17, under 35 U.S.C. 102(e), as being anticipated by Bloom, US 2002/0178074 A1. A prima facie case of anticipation has not been established.
3. Even if Bloom had been available for use by the Examiner as a reference, it was erroneous to reject Claim 4, under 35 U.S.C. 103, over Bloom, in view of ordinary skill in the art. A prima facie case of obviousness has not been established.
4. Even without the above-mentioned Declaration, it was erroneous to cite a published U.S. patent application by Yang, US 2002/016289A1 (filing date Jan. 22, 2002, claiming priority to an application filed June 28, 2001), because these dates are later than the filing date of the subject application. Thus on the face of Yang's application, it appears that this is not available for use by the Examiner as a reference.

1. Argument for withdrawing the rejection of Claims 1-17:

As stated in MPEP 2136.05, "a 35 U.S.C. 102(e) rejection can be overcome by

antedating the filing date ... of the reference by submitting an affidavit or declaration under 37 CFR 1.131" Along with this Reply, the Assignee submits a Declaration under 37 CFR 1.131, signed by the inventors on December 19, 2003, to prove a date of invention that antedates Bloom. Bloom is not actually "prior" art. Therefore the rejection of Claims 1-17 should be withdrawn.

Rule 37 CFR 1.131(a), reproduced in MPEP 715, allows submitting a "declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based." The Assignee submits this Declaration to show "conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to ... the filing of the application," as described in 37 CFR 1.131(b). Specifically, this Declaration shows Dr. Banerjee's and Dr. Dutta's conception of the invention prior to October 31, 2000 (and thus prior to March 16, 2001, the claimed priority date of the Bloom reference) coupled with due diligence from prior to March 16, 2001 to the filing of Dr. Banerjee's and Dr. Dutta's application on June 7, 2001. This Declaration is made by Dr. Banerjee and Dr. Dutta, who are "all the inventors of the subject matter claimed," as described by MPEP 715.04.

2. Argument regarding 35 U.S.C. 102(e) and lack of a prima facie case of anticipation:

As stated in MPEP 2131, to anticipate a claim, a reference must teach every element of the claim. The following arguments point out some limitations in the rejected claims which are not described in the reference relied upon (Bloom). Thus

a prima facie case of anticipation has not been established.

A. Argument for Claim 1:

Consider "presenting to said buyer a buyer-preferred delivery option," a limitation in rejected Claim 1, which Bloom does not describe. Also consider "making said goods available for pick-up by said buyer's preferred delivery agency," another limitation in rejected Claim 1, which Bloom does not describe. Banerjee and Dutta's Background of the Invention, paragraph [0002], points out a problem: "Electronic commerce methods in use today typically give the buyer of goods relatively little choice in how the goods will be transported from seller to buyer, and relatively little control over the shipping cost." An example of a solution involving a buyer-preferred delivery option is given in Banerjee and Dutta's Summary of the Invention, paragraph [0007]: "A buyer of goods in electronic commerce may enjoy economic benefits by specifying the buyer's preferred delivery agency as the means for shipping goods, negotiating shipping charges with the buyer's preferred delivery agency, and paying the buyer's preferred delivery agency directly. Both buyer and delivery agency could benefit by an arrangement where a single delivery agency's services were used to satisfy all or most of a buyer's shipping requirements, especially if the buyer were a business or institution." Banerjee and Dutta's description of FIG. 2, paragraph [0031], describes an example of presenting to the buyer a buyer-preferred delivery option: "Shipping options web page 214 is an example of one way to transmit, from Seller's web server 210 to buyer's web client 230, an indication that shipment of goods may be accomplished via buyer's preferred delivery agency.... A darkened circle on shipping options web page 214 shows input from the buyer, requesting shipment of goods via a buyer's preferred

delivery agency."

Banerjee and Dutta describe the source of a problem: little choice or control for the buyer. Bloom does not identify the problem. On the contrary, Bloom is an example of the problem, giving the buyer of goods relatively little choice or control: "retailers can also offer the more efficient ePackage Depot (ePD) delivery option. The ePD delivery option can typically be priced lower than other delivery options, since it requires the recipient to pickup their order from a customer distribution center (CDC) (or destination centralized pickup location)" Bloom, paragraph [0071] [emphasis added]. The ePackage Depot and customer distribution center are the focus of the paragraphs in Bloom's application that are cited by the Examiner. For example: "The values written to the following fields can be provided by the customer: Customer Id, Ordering Customer Id, ePD Shipper Id (if the retailer offers a choice of more than one shipper for ePD delivery)..." Bloom, paragraph [0077] [emphasis added].

Thus one can see that Bloom's notion of an "option" is quite narrow, and Bloom's method is not open to receiving inputs regarding the buyer's true preferences. Bloom requires the buyer to travel to a customer distribution center to pick up the goods, and may require the buyer to do business with only one shipper, selected by the retailer, not the buyer. Bloom's method does not address problems involved in extending delivery services "the last mile" to the buyer's home or business, according to the buyer's preferences. Banerjee and Dutta's Claim 1 involves a buyer's preferred delivery agency that delivers goods to a buyer (see Banerjee and Dutta's paragraph [0023]). In contrast, Bloom's shipper is chosen primarily by the

retailer, and that shipper delivers goods not to a buyer, but rather to a centralized pickup location, because that is more efficient for the retailer and the shipper.

The description of FIG. 5, paragraph [0034], describes another example of presenting to the buyer a buyer-preferred delivery option: "At block 510, Seller's server sends to Buyer's client a price for some goods without added shipping cost, and an indication that shipment of the goods may be accomplished via Buyer's preferred delivery agency.... At decision 530, if this Buyer already has a preferred delivery agency, the "Yes" branch is taken...." In contrast, Bloom's method will not accommodate a Buyer who already has a business relationship with a buyer's preferred delivery agency. In Bloom's method, it is the retailer who chooses one or more shippers who are eligible to transport goods to a CDC or centralized pickup location. (The retailer's chosen shipper need not specialize in transporting goods to a CDC. This is the meaning of the sentence at the end of Bloom's paragraph [0071] about also providing "traditional package delivery service.")

Consider the example in Banerjee and Dutta's Summary of the Invention, paragraph [0007]: "A buyer of goods... negotiating shipping charges with the buyer's preferred delivery agency," together with their description of FIG. 5, paragraph [0034], concerning block 540, where the buyer "may interact with that delivery agency's system to establish that agency as the buyer's preferred delivery agency." This kind of negotiation and two-way interaction is missing from Bloom's method, where little or nothing is open for the buyer to negotiate.

B. Rejected Claims 2-8 are not separately argued. The points made above, concerning a buyer's preferred delivery agency, also apply to Claims 2-8.

C. Argument for Claim 9:

Consider "a request for shipment of said goods to said buyer via said buyer's preferred delivery agency; transmitting from said first computer, over said communications network, shipping information regarding said goods, said shipping information including an identifier of said goods, and a time and a place for pick-up of said goods by said buyer's preferred delivery agency; ... and transmitting a signal, from said second computer, to direct the transportation of said goods to said buyer via said buyer's preferred delivery agency" These are limitations in rejected Claim 9, which Bloom does not describe. For example, consider Banerjee and Dutta's description of FIG. 4, paragraph [0033]: "At block 430, Buyer's client sends some shipping information, shown as "shipping data D" to a server for Buyer's preferred delivery agency, along with a delivery address for this shipment." Such transmissions of information, to arrange transportation of goods to the buyer via the buyer's preferred delivery agency, are not described by Bloom, because Bloom's method is not open to receiving inputs regarding the buyer's true preferences. Rather than describing transmissions of information, to arrange transportation of goods to the buyer, Bloom describes communications involved in the recipients picking up their goods from a centralized pickup location. Bloom describes, in paragraph [0072], conveying information as to where the buyer may go to pick up the goods (a destination centralized pickup location). Bloom describes, in paragraph [0025] an electronic notification that it is time for the buyer to pick up the goods (at

a destination centralized pickup location).

D. Rejected Claims 10-17 are not separately argued. The points made above, concerning a buyer's preferred delivery agency, and transmissions of information, to arrange transportation of goods to the buyer, also apply to Claims 10-17.

3. Argument regarding 35 U.S.C. 103 and lack of a prima facie case of obviousness:

As stated in MPEP 2143 and 2143.03, a requirement for establishing a prima facie case of obviousness is that the reference or references must teach or suggest all the claim limitations. Regarding rejected Claim 4, the reference (Bloom) does not teach or suggest all the claim limitations. The points made above, concerning Claim 1, a buyer-preferred delivery option and a buyer's preferred delivery agency, also apply to Claim 4, which depends upon Claim 1. Thus a prima facie case of obviousness has not been established.

4. Argument regarding published application by Yang:

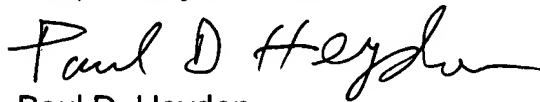
This apparently is not available for use by the Examiner as a reference (not "prior art"), because Yang's filing date of Jan. 22, 2002, and claimed priority date of June 28, 2001 are later than June 7, 2001, the filing date of the subject application. On the face of Yang's published application, it appears that this is not available for use by the Examiner as a reference. From the Rejection, it cannot be determined how the Examiner intended to use Yang's published application, or whether Yang's prior application(s) properly support the subject matter used to make the rejection (see

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MPEP 706.02(f)(1)).

Assignee respectfully submits that the rejection of Claims 1-17 should be withdrawn, and requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

A handwritten signature in black ink, reading "Paul D. Heydon". The signature is fluid and cursive, with the first name "Paul" and last name "Heydon" clearly distinguishable.

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